

Appl. No. 10/678,206
 Any. Docket No. 9049
 Amdt. dated 3/19/2007
 Reply to Office Action of 12/19/2006
 Customer No. 27752

REMARKS

Rejections Under 35 USC 103(a) Over U.S. Patent No. 1,342,994 to Fitzgerald

Claims 1, 4-11, 14, and 15 are rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 1,342,994 to Fitzgerald ("Fitzgerald"). The Examiner asserts that Fitzgerald discloses a hair treatment applicator (figs. 2, 3, and 5) comprising a handle (4) having a longitudinal axis and being in an elongated form; a plurality of retaining structures or heads (9) connected to the handle, each of the plurality of retaining structures having a base (11) and a plurality of tines (12) and being configured for holding hair treatment (soap, fig. 5), wherein the base facing in a direction substantially parallel to that of each other retaining structures and each of said plurality of tines extends substantially perpendicular from the base; wherein each of the retaining structures being separated from each other by a separation volume.

Applicants respectfully traverse the present rejection based on the following comments. First, the Fitzgerald patent is not analogous prior art and thus cannot be relied upon as the basis for a rejection. Furthermore, the Examiner has failed to establish a *prima facie* case of obviousness based on Fitzgerald because there is no suggestion or motivation to modify Fitzgerald. Alternatively, Fitzgerald does not teach or suggest all of Applicants' claim limitations and, therefore, does not establish a *prima facie* case of obviousness.

Prior to making a determination of obviousness, the Examiner must determine what is analogous prior art. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned."¹ A reference is considered reasonably pertinent if the "subject matter disclosed therein is relevant to the particular problem with which the inventor is involved."²

In this case, the Fitzgerald patent, entitled "Bath-Spray," is directed to a combined bath-spray and massage device, designed to be connected to a water inlet. The Fitzgerald patent is outside the pertinent field of endeavor – hair treatment applicators. Furthermore, the subject matter of the Fitzgerald patent is not relevant to the particular problem with which the applicants were involved. Namely, the Fitzgerald patent addresses the problem of providing a spray head with massage members that produces the "most advantageous spraying and

¹ *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992).

² *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069 (Fed. Cir. 2003).

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massaging effects.”³ In stark contrast, the present invention is directed to a hair treatment applicator that allows for a separation between treated and untreated hair. The applicator provides for a separate and distinct set of treated hair or highlights, over two separate sections of hair, and an untreated section of hair in between the two treated sections of hair.

Nothing in the Fitzgerald “Bath-Spray” patent “logically would have commended itself” to the inventors’ attention in considering the problem of providing for a separation between treated and untreated hair.⁴ Because the Fitzgerald reference is neither in the field of the applicants’ endeavor nor reasonably pertinent to the particular problem addressed by the applicants, it is not analogous art.

Moreover, there is no suggestion or motivation to modify the teachings of Fitzgerald to achieve the modified bath-spray and massage device of Fitzgerald as proposed by the Examiner. Indeed, the modifications proposed by the Examiner would render the bath-spray and massage device of Fitzgerald unsatisfactory for its intended purpose, and the modifications would change the principle of operation of the Fitzgerald invention. If a proposed modification renders the prior art invention being modified unsatisfactory for its intended purpose⁵ or changes the principle of operation of the prior art invention⁶, then there is no suggestion or motivation to make the proposed modification. Consequently, a *prima facie* case of obviousness has not been established.

As acknowledged by the Examiner, Fitzgerald fails to show the handle of the bath-spray/massage device being integrally molded with each of the retaining structures, such that the device is molded as a single piece.⁷ Fitzgerald, in fact, discloses that one of the “objects” of the invention is to “provide a device of the character described in which the perforated face plate of the spray head is provided with a plurality of detachable massage members.”⁸ Further, Fitzgerald discloses that the invention is “*particularly effective* for the reason that the massaging [members] are removable and may be replaced when worn out or . . . by other massaging or body contacting device [i.e., sponge]”⁹ Fitzgerald teaches that some of the massaging members, i.e., the central member, may be removed to “permit a greater

³ Fitzgerald, at column 1, lines 19-24.

⁴ *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992).

⁵ See *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984); see also MPEP 2143.01 at 2100-129 (Rev. 5, Aug. 2006).

⁶ *In re Ratti*, 270 F.2d 810 (CCPA 1959).

⁷ Office Action, page 3.

⁸ Fitzgerald, column 1, lines 14-19.

⁹ Fitzgerald, column 3, lines 30-37.

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discharge of water therethrough.”¹⁰ The claims of the Fitzgerald patent even require that the massage members be detachably connected to the face plate of the spray head. Thus, the bath-spray/massage device of Fitzgerald is designed to provide a user with the option of attaching various numbers of massage members at various positions on the spray device.

Consequently, to modify the bath-spray/massage device of Fitzgerald to make the device integrally molded as a single piece would render the device unsatisfactory for the above-described purpose. Such a modification would render the device unsatisfactory because the massage members would not be detachable or replaceable. A user would not be able to select the level of water discharge from the spray device or the arrangement of the massage members. Such a modification would also change the principle of operation of the Fitzgerald invention, which emphasizes detachability of massage members. Therefore, there is no suggestion or motivation to modify Fitzgerald to achieve the modified, integrally molded spray-bath/massage device proposed by the Examiner.

Alternatively, the modification of Fitzgerald does not teach or suggest all of Applicants’ claim limitations and, therefore, does not establish a *prima facie* case of obviousness. Applicants’ claim 1 is directed to a hair treatment applicator for applying a hair treatment to hair. As currently amended, this hair treatment applicator comprises a handle and a plurality of retaining structures connected to the handle, each of the plurality of retaining structures comprising a base and a plurality of tines and being configured for holding the hair treatment; wherein each of the retaining structures is separated from each other of the plurality of retaining structures by a separation volume.

In contrast, the disclosure of Fitzgerald fails to disclose a hair treatment applicator. Fitzgerald fails to disclose a hair treatment applicator, as currently claimed, which has a plurality of retaining structures configured for holding hair treatment. As discussed above, the disclosure of Fitzgerald is directed to, and is limited to, a bath-spray/massage device. Nothing in the disclosure of Fitzgerald teaches or suggests that the bath-spray device is configured for anything other than providing spraying, sometimes soapy spraying, and massaging effects. The bath-spray device is not configured for holding hair treatment.

The Examiner asserts that the disclosure of a bath-spray/massage device “with a soap container so located that the water coming into the spray head from the water inlet discharges

¹⁰ Fitzgerald, column 4, lines 38-44.

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directly upon the soap within the container to provide a soapy spray"¹¹ reads on a hair treatment applicator "configured for holding said hair treatment." The Applicants respectfully submit that the "soap basket" of the Fitzgerald patent is quite different from the retaining structures of the present invention. In particular, Fitzgerald teaches that the soap basket has an "open construction," such as wire mesh. Such an open construction would be necessary if the water coming into the spray head is to discharge directly upon the soap. Such an open construction, however, is inconsistent with the operation of the present invention. Under such conditions of open construction, it would be difficult if not impossible to hold the hair treatment or control where it is applied, i.e., provide for separation between treated and untreated hair. Furthermore, the Fitzgerald device does not comprehend separation volumes, as currently claimed. The massage members of the Fitzgerald device need not be separated by a separation volume. The massage members need merely be arranged such that they "do not interfere with the proper spray discharge." And, the individual massage fingers of each massage member need not be separated by a separation volume. The present invention requires a separation volume to allow a section of hair to pass through the hair treatment applicator without being treated. Thus, Fitzgerald fails to disclose a hair treatment applicator configured for holding the hair treatment and including a separation volume.

Therefore, the Fitzgerald patent fails to teach or suggest all of Applicants' claim limitations and, therefore, does not establish a *prima facie* case of obviousness.

With respect to new claims 4-14, an argument analogous to that made with respect to claim 1 can be made because claims 4-14 depend directly or indirectly from claim 1.

Likewise, with respect to new independent claims 15 and 16, an argument analogous to that of claim 1 can be made because each claim recites the relevant limitations of claim 1 discussed above.

Consequently, the Examiner has failed to establish a *prima facie* case of obviousness based on Fitzgerald. Namely, there is no suggestion or motivation to modify Fitzgerald, or, alternatively, Fitzgerald, as modified, does not teach or suggest all of Applicants' claim limitations. Therefore, Applicants' claims 1, 4-11, 14, and 15 are unobvious over Fitzgerald.

¹¹ Fitzgerald, column 3, lines 4-10.

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Rejections Under 35 USC 103(a) Over WO 00/69308

Claims 1, 12, and 13 are rejected under 35 USC 103(a) as being unpatentable in view of WO 00/69308 (the '308 application). Claim 16 also appears to be rejected over the '308 application. Regarding claims 1 and 16, the Examiner asserts that the '308 application discloses a hair treatment applicator (figs. 3 and 4) *comprising a handle* (1) having a longitudinal axis and being in an elongated form; a plurality of retaining structures or heads (at 5) connected to the handle, each of the plurality of retaining structures having a base (4) and a plurality of tines (5) and being configured for holding hair treatment; wherein the base facing in a direction substantially parallel to that of each other retaining structure and each of said plurality of tines extends substantially perpendicular from the base; wherein each of the retaining structure being separated from each other by a separation volume (10) and wherein the hair treatment being contained in each of the plurality of retaining structures and is not contained in the separation volume.

Applicants respectfully traverse the present rejection based on the following comments. With respect to claims 1 and 16, the '308 application does not disclose each and every element of Applicants' claimed hair treatment applicator, and, thus, does not establish a *prima facie* case of obviousness.

Claims 1 and 16 require hair treatment applicators that comprise a *handle* having a longitudinal axis and being molded from one or more plastic materials in an elongated form. The elongated form of the handle allows a user to grasp the hair treatment applicator in his or her hand for good control and maximum comfort in its use.

In contrast to Applicants' hair treatment applicator of claims 1 and 16, the application device of the '308 application does not comprise a handle at all. Instead, the '308 application relates to an "application device which is configured in such a way that said device can be mounted on the opening of a container that receives or contains hair dyeing agents."¹² The '308 application does not disclose a handle, in an elongated form, which can be grasped in the hand of a user during use.

Thus, as it fails to disclose each and every element of Applicants' claimed hair treatment applicator, the '308 application does not establish a *prima facie* case of obviousness. Therefore, Applicants' claims 1 and 16 are unobvious over the '308 application. Additionally, with respect to claims 12 and 13, an argument analogous to that

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made with respect to claim 1 can be made because claims 12 and 13 depend directly or indirectly from claim 1.

CONCLUSION

In light of the amendments and remarks presented herein, it is requested that the Examiner reconsider and withdraw the present rejections. Early and favorable action in the case is respectfully requested.

Applicant has made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicant respectfully requests reconsideration of this application and allowance of Claims 1 and 4-16.

Respectfully submitted,
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¹² '308 application, Abstract.